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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/418,509 10/15/99 ROCHON

D 7791-0081-25

EXAMINER

TM02/0813

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ART UNIT

PAPER NUMBER

2162
DATE MAILED:

08/13/01

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

SR

Office Action Summary

Application No.

09/418,509

Applicant(s)

ROCHON ET AL.

Examiner

Jean D Janvier

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

Response to Amendment

By filing a CPA, the Applicants have taken advantage of the AIPA's exclusion under 35 USC 103(c) relating to common assignment, thereby making the Scroggie's reference (US Patent 6, 014, 634) under 102(e) null and void or inapplicable. However, the Applicants were aware of another identical Scroggie's reference, WO 97/23838, sent to the Office as part of the IDS. Since the Applicants were aware of this reference, WO 97/23838, and failed, among other things, to amend the claims to overcome an identical art rejection under 102(b), **the following Office Action based on the Sroggie's reference WO 97/23838 HAS BEEN MADE.**

Furthermore, the Applicants' argument was not persuasive. In fact, as per claim 1, the Applicants referred, among other things, to a prior Non-Final first Office Action. Since the Applicants' argument, in response to the Non-Final first Office Action, was moot in view of a new ground of rejection and since the prior art used in that Office Action was not used during the second Non-Final Office Action based on the Scroggie's reference (US Patent 6, 014, 634), the Applicants' response, as it stands, is null and void.

Although this finality may seem to be premature, it is necessitated by the Applicants' response since a Non-Final Rejection would not in any way help advance prosecution.

DETAILED ACTION

Status of the case

Claims 1-37 were originally presented. After the first Non-Final Office Action, claims 4, 16, 19, 22 and 29 were merely amended and claims 32-37 were added. A total of 37 claims are now pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 31, 34 and 37 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either an asserted utility or a well-established utility.

Claims 31, 34 and 37 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either an asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

Please remember that a computer program product encoded on a computer readable medium can not by itself perform any task. An acceptable format to claim a computer program product is presented below-

A computer program product encoded on a computer readable medium or storage medium is enabled, when executed on a processor or computer, to perform-

Function A

Function B

....

Function N

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Scroggie et al, WO 97/23838.

As per claims 1-15, 32 and 35, Scroggie et al teach a method comprising the steps of:

1.

Transmitting a signal via **Log-in Page 16 of fig.1** prompting a user **10** to provide profile data, upon completing **Form 82 of fig.2**, including identification of the user from a main computer or a **Server or a Computer at a central site** over computer network or **Internet 304 of fig.13** to a network address or **IP address** for the user's computer **302 of fig.13** (See abstract- page 2 lines 1-7 and page 10 lines 5-17);

Transmitting a manufacturer's sample offer 154 of fig.5 (page 12 lines 11-26 and page 13 lines 2-5) or other variety of offers stored in storage device or Hard Disk 306 of fig.13 by manufacturers, from said main computer or Server 300 of fig.13 over said computer network or Internet 304 of fig.13 to said network address or IP address for said user's computer 302 of fig.13 (page 18 line 20 to page 19 line 12) if said user's profile data such as Zip code, preferences and buying pattern meet user profile criteria associated with a manufacturer's sample offer for a sample 154 of fig.5 (page 4 lines 3-10 and page 21 lines 4-21) of a product; and

Generating instructions for providing said sample 154 of fig.5 of said product or other variety of offers to said user 10 of fig.1 if said main computer or Server 300 of fig.13 receives a signal transmitted over said computer network 304 of fig.13 indicating said user accepts said manufacturer's sample offer (fig.14 and page 19 line 15 to page 20 line 8).

2. The method further comprising the step of:

Determining, upon comparing user's profile data with a manufacturer's profile data to qualify a user for an incentive or product sample offer 154 of fig.5, if said user's profile data or demographic data meet said user profile criteria associated with said manufacturer's sample offer or other variety of offers for a sample of said product (page 21 lines 14-21).

3. The method further comprising the step of:

Determining if said main computer or Web Server or Web Site 508 of fig.15 receives, subsequent to sending an e-mail to user 10 regarding the manufacturer's weekly offers 520

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such a product sample 154, said signal or response transmitted over said computer network or Internet 304 indicating said user accepts said manufacturer's sample offer or weekly offers upon reading the content of e-mail and accepting the weekly offers or sample 154 from the manufacturers by sending an e-mail to the manufacturers via Internet 304 (fig.15- p.19 lines 15-25).

4. (Amended) The method further comprising the step of:

Determining, upon tracking user 10 transaction on-line or in the store via user 10 identification such as credit card, debit card or magnetic check or any other acceptable, if said user purchases a product for which said instructions for providing said sample of said product are generated (Anticipated in the art- p.19 lines 15-25).

5. Wherein said transmitting said manufacturer's sample offer comprises the step of:

Storing said profile data in a consumer database 506 of fig.15.

6. The method further comprising the step of:

Transmitting a solicitation for feedback, by sending an e-mail or prompting user 10 to provide an evaluation of the product during product registration, regarding said product from said main computer or Server or Web Site over said computer network or Internet 304 to said network address or IP address for said user's computer 510 (Anticipated in the art).

7. Wherein said step of transmitting a signal comprises:

Transmitting a signal prompting said user to provide said user's postal mailing address
(p.14 line 24 to p.15 line 2).

8. The method further comprising the step of:

Transmitting a record containing the postal mailing address of said user from said main computer to a network address for a third party **or Fulfillment House 158 of fig.5**. (P.12 line 29 to p.13 line 5).

9. The method further comprising the step of:

Mailing a coupon discounting a full price of said sample, **or mailing a coupon or a token that allows user 10 to pick up a sample offer 154 at a selected retailer (since the sample is free as anticipated by Scroggie et al)**, to a postal mailing address of said user (p.1 lines 10-12).

10. The method further comprising the step of:

Mailing said sample to a postal address for said user (see abstract and p.12 line 25).

11. Wherein said step of delivering comprises:

Transmitting an electronic discount or coupon to a point of sale terminal, **which allows user 10 to pick up a sample offer 154 at a selected retailer (since the sample is free as anticipated by Scroggie et al)**, for the full price of said sample in a current transaction, if said main computer

had received said signal indicating said user involved in said transaction had accepted said manufacturer's samples depicted in figs. 13 and 14 (p.18 line 21 to p.19 line 7).

12. Wherein said step of transmitting said manufacturer's sample offer comprises the step of:
Sending e-mail, which contains a token attachment over the computer network or Internet 304 to said user 10 (see figs 13, 14 and 15).

13. The method further comprising the step of:
Storing said profile data and purchase data regarding a user's purchase in association with a unique identifier uniquely identifying said user in a consumer database 506 of fig.15, integrated with Consumer Purchase History database 502, (p.20 lines 17-24).

14. The method further comprising the step of:
Determining consumer conversion based at least in part on said purchase data stored in said consumer database 506 of fig.15, integrated with Consumer Purchase History database 502, upon tracking user 10 transaction on-line or in the store via user 10 identification such as credit card, debit card or magnetic check or any other acceptable (p.19 lines 15-25).

15. The method further comprising the step of:
Transmitting said manufacturer's sample 154 offer or Weekly offers 520 from Manufacturers 518 from said main computer or Web Site 508 or Server 300 over said computer network or Internet 304 to said network address or IP address for said user's

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computer 510 or 302 only if said user's profile data meet said user profile criteria **stored in database 506** and said purchase history data meets purchase history criteria associated with said manufacturer's sample offer for said sample of said product **or any other incentive** (fig.15- p.19 line 15 to p.20 line 8 and p.21 lines 8-21).

32. (New) Wherein said step of transmitting a manufacturer's sample offer for a sample 154 of a product comprises transmitting a manufacturer's sample offer for a sample of a packaged good product (clearly anticipated by Scroggie et al).

35. (New) Wherein the step of generating instructions for providing said sample of said product to said user comprises generating instructions for packing and shipping the sample of the product to said user **using user 10 postal mailing address** (Anticipated-see abstract and p. 12 lines 11-26 and p.13 lines 2-5).

As per claims 16-30, 33 and 36, Scroggie et al disclose a system comprising:

16. (Amended) A computer network system, comprising:

A main computer (300) of fig.13 or (508) of fig.15, said main computer configured:

To transmit a signal **via Log-in Page 16 of fig.1** prompting a user 10 to provide profile data, **upon completing Form 82 of fig.2**, including identification of the user from a main computer **or a Server or a Computer at a central site over computer network or Internet 304**

**of fig.13 to a network address or IP address for the user's computer 302 of fig.13 (See abstract-
p.2 lines 1-7 and p.10 lines 5-17);**

**To transmit a manufacturer's sample offer 154 of fig.5 (p. 12 lines 11-26 and p.13 lines
2-5) or other variety of offers stored in storage device or Hard Disk 306 of fig.13 by
manufacturers, from said main computer or Server 300 of fig.13 over said computer network
or Internet 304 of fig.13 to said network address or IP address for said user's computer 302 of
fig.13 (p.18 line 24 to p.19 line 12) if said user's profile data such as Zip code, preferences and
buying pattern meet user profile criteria associated with a manufacturer's sample offer for a
sample 154 of fig.5 (p.4 lines 3-10 and p.21 lines 4-21) of a product; and**

**To generate instructions for providing said sample 154 of fig.5 of said product or other
variety of offers to said user 10 of fig.1 if said main computer or Server 300 of fig.13 receives a
signal transmitted over said computer network 304 of fig.13 indicating said user accepts said
manufacturer's sample offer (fig.14 and p.19 line 15 to p.20 line 8)**

17. The system further comprising;

**Means such an anticipated comparator for determining, upon comparing user's
profile data with a manufacturer's profile data to qualify a user for an incentive or product
sample offer 154 of fig.5, if said user's profile data or demographic data meet said user profile
criteria associated with said manufacturer's sample offer or other variety of offers for a sample
of said product (p.21 lines 14-21).**

18. The system further comprising;

Means for determining if said main computer or Web Server or Web Site 508 of fig.15 receives, subsequent to sending an e-mail to user 10 regarding the manufacturer's weekly offers 520 such a product sample 154, said signal or response transmitted over said computer network or Internet 304 indicating said user accepts said manufacturer's sample offer or weekly offers upon reading the content of e-mail and accepting the weekly offers or sample 154 from the manufacturers by sending an e-mail to the manufacturers via Internet 304 (fig.15-p.20 lines 2-14).

19. (Amended) The system of claim 16, further comprising:

Means for determining, upon tracking user 10 transaction on-line or in the store via user 10 identification such as credit card, debit card or magnetic check or any other acceptable, if said user purchases a product for which said main computer 300 or 508 is configured to generate instructions for providing said sample of said product (Anticipated by Scroggie et al- p.19 lines 15-25).

20. The system further comprising:

A consumer database 506 of fig.15 for storing said profile data.

21. The system further comprising:

Means such as communication tools for transmitting a solicitation for feedback, by sending an e-mail or prompting user 10 to provide an evaluation of the product during product registration, regarding said product from said main computer or Server or Web Site

over said computer network or **Internet 304** to said network address or **IP address** for said user's computer 510 (Anticipated by Scroggie).

22. (Amended) The system further comprising:

Means as described in **figs. 1 and 2** for transmitting a signal prompting said user to provide said user's postal mailing address (p.14 line 24 to p.15 line 2).

23. The system further comprising:

Means as described in **fig. 5** for transmitting a record containing the postal mailing address of said user from said main computer to a network address for a third party or **Fulfillment House 158 of fig.5** (p.12 line 29 to p.13 line 5) for further processing.

24. The system further comprising:

Means for mailing a coupon for a free one of said samples, or mailing a coupon or a token that allows user 10 to pick up a sample offer 154 at a selected retailer (since the sample is free as anticipated by Scroggie et al), to a postal mailing address of said user (p.1 lines 10-12).

25. The system further comprising:

Means for mailing said sample to a postal address for said user via well established Post Office, UPS and so on (see abstract and p.12 line 25).

26. The system further comprising:

Means **such as communication tools** for transmitting an electronic discount or coupon to a point of sale terminal, **which allows user 10 to pick up a sample offer 154 at a selected retailer (since the sample is free as anticipated by Scroggie et al), for the full price of said sample in a current transaction, if said main computer had received said signal indicating said user involved in said transaction had accepted said manufacturer's samples depicted in figs. 13 and 14 (p.18 line 21 to p.19 line 7).**

27. The system further comprising:

Means for sending e-mail, **which contains a token attachment** over the computer network or **Internet 304** to said user 10 (see figs 13, 14 and 15).

28. The system further comprising:

Means **or storage medium or Hard Disk** for storing said profile data and purchase data regarding a user's purchase in association with a unique identifier uniquely identifying said user in a consumer database **506 of fig.15, integrated with Consumer Purchase History database 502,** (p.20 lines 17-24).

29. (Amended) The system further comprising:

Means for determining consumer conversion based at least in part on said purchase data stored in said consumer database **506 of fig.15, integrated with Consumer Purchase History database 502, upon tracking user 10 transaction on-line or in the store via user 10**

identification such as credit card, debit card or magnetic check or any other acceptable payment instrument (p.19 lines 15-25).

30. (Amended) The system further comprising:

Means for transmitting said manufacturer's sample **154 offer or Weekly offers 520 from Manufacturers 518** from said main computer **or Web Site 508 or Server 300** over said computer network **or Internet 304** to said network address **or IP address** for said user's computer 510 or 302 only if said user's profile data meet said user profile criteria **stored in database 506** and said purchase history data meets purchase history criteria associated with said manufacturer's sample offer for said sample of said product **or any other incentive** (fig.15- p.19 line 15 to p.20 line 8 and p.21 lines 8-21).

33. (New) Wherein said main computer 300 or 508 is configured to transmit a manufacturer's sample offer for a sample 154 of a packaged good product (Clearly anticipated by Scroggie et al).

36. (New) Wherein said main computer 300 or 508 is configured to generate instructions for packing and shipping the sample of the product to said user **using user 10 postal mailing address** (Anticipated-see abstract and p.13 lines 2-5).

As per claims 31, 34 and 37, Scroggie et al teach -

A computer program or any other custom-built package written by experienced computer programmers encoded on a readable medium or Hard Disk to perform, when executed on a computer or main computer 300 or 508, the following tasks as anticipated by Scroggie et al:

Transmitting a signal prompting a user to provide profile data including identification of the user from a main computer over a computer network to a network address for the user's computer;

Transmitting a manufacturer's sample/Offer from said main computer over said computer network to said network address for said user's computer if said user's profile data meets user profile criteria associated with manufacturer's sample offer for a sample of a product; and

Generating instructions for providing said sample of said product to said user if said main computer receives a signal transmitted over said computer network indicating said user accepts said manufacturer's sample offer.

Conclusion

Although US Patents 6,026,370 to Jermyn, 6,006,197 to d'Eon et al, 5,918,213 to Bernard et al, 6,021,362 to Maggard et al, 5,907,830 to Engel et al, 5,948,061 to Merriman et al, 5,502,636 to Clarke and www.freesamples.com were not used in this Office Action, they were highly considered as relevant prior Art. Applicants are further directed to consult these references.

WWW.freesamples.com- the claimed invention was disclosed in freesamples.com where a user could log into the site and select a particular free sample of a product, which can be downloaded or mailed to the user's mailing address, upon registering with the web site.

Please, in the future, provide the Examiner not only with a clean copy of all pending claims, but also with support, that is page and line numbers, for all amended and/or new claim language; otherwise, the amended and/or new claim language will be considered as new matter.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (703) 308-6287). The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner

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by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (703) 305- 8469.

For information on the status of your case, please call the help desk at
(703) 305-3900.

8/10/01


ERIC W. STAMBER
PRIMARY EXAMINER